

### REMARKS

This amendment is in response to the Office Action of July 8, 2003, in which claims 1-3 were allowed and claims 4-7 were rejected. Specifically, independent claims 4 and 7 were rejected under 35 U.S.C. 103 for obviousness over U.S. Statutory Invention Registration H1745 to Paraschac in view of U.S. Patent no. 6,464,700 Koblish. Dependent claims 5 and 6 were rejected over Paraschac and Koblish in view of U.S. Patent No. 5,680,860 to Imran.

### CLAIM 4

According to the Office Action, Paraschac discloses, inter alia, grasping jaws with a conductive ablation member 27 and a receding clamping surface 26.

It is respectfully submitted that the insulation layer 26 in Paraschac is not a receding clamping surface as set forth in claim 4. First, it should be noted that the device described in Paraschac is in the class of devices that are for clamping and coagulating tissue, which tissue may then be severed without substantial blood loss. As such, the Paraschac device is not intended to define insulative lines of ablation in cardiac tissue, but regions of complete coagulation to stop or slow

bleeding in tissues that are being severed and employs one or more relatively wide electrodes for current flow.

It is also respectfully submitted that insulation layer 26 is not receding clamping surface as claimed. Insulation layer 26 covers most of the electrode 21. The ends of the layer 26 are spaced from clamping surface 27 to leave small conductive or transition regions 29 exposed. The fact that the edge of insulative layer 26 is spaced from the surface 27, does not make it a receding clamping surface as claimed, for several reasons. First, the respective clamping surface in Paraschac is clamping surface 27 and the edge of insulative layer 26 is not described or discussed as forming part of the clamping surface.

Even if the edge of the insulative layer 26 were part of a clamping surface, it is merely spaced from the surface 27 and is not "receding" - - which denotes a surface that moves back or away from the conductive member. To make this clearer, claim 4 has been amended to recite that the receding clamping surface of each jaw defines a surface of varying distance from the respective conductive member. Applicant does not view this additional language as a limitation, but rather as a clarification of what "receding" means. Such a surface could be, for example, receding gradually, abruptly, continuously or

stepwise, but in any event is of varying distance from the conductive member -- which is clearly different from and not suggested by the edge of the insulation layer 26 shown in Figure 3 of the Paraschac Registration.

It is also submitted that there is no suggestion or motivation to add the temperature sensor of the Koblisch patent to the coagulation clamp of Paraschac. Paraschac does not describe or suggest a clamping device suitable for forming non-conductive ablation lines in cardiac tissue to treat atrial fibrillation, and there is no need or logic to adding a temperature sensor to the Paraschac device. The simple fact that Koblisch discloses a temperature sensor (on a flexible shaft, coil electrode device) does not provide any motivation or reason to add such a sensor to the Paraschac coagulation clamp, which has an entirely different structure and function.

For all the above reasons, it is respectfully submitted that independent claim 4 and dependent claim 5 and 6, which add further features, are not taught or suggested by the cited prior art and should be allowable.

#### **CLAIM 7**

Claim 7 is directed to a tissue clamping device with first and second jaws movable between open and clamping positions for

receiving and compressing tissue therebetween. At least one of the jaws has a thermocouple to measure the temperature of tissue held between the jaws in the clamped position.

No tissue clamping device employing a temperature sensing thermocouple has been cited or suggested by the cited prior art. The Koblish patent discloses a temperature sensor only in the context of flexible catheter-like instrument that rests against the surface of the tissue -- not a tissue-compressing clamp as claimed. The Paraschac clamp, as described above, is a coagulation clamp and there is no suggestion or rationale suggested for a thermocouple temperature sensor in the jaw of such a clamp. For these reasons, it is respectfully submitted that the subject matter of claim 7 is not disclosed or suggested by the cited prior art, whether considered individually or together.

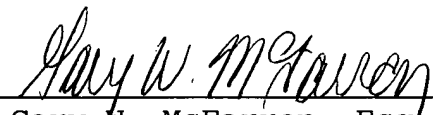
**CONCLUSION**

Reconsideration and allowance of claims 1-7 are respectfully requested.

Respectfully submitted,

Date: October 2, 2003

By:



Gary W. McFarron, Esq.

Registration No. 27,357

Cook, Alex, McFarron, Manzo,  
Cummings & Mehler, Ltd.

200 West Adams St., Suite 2850

Chicago, IL 60606

Telephone: (312) 236-8500

Attorneys for Applicant